

REMARKS**Status of the Claims**

Upon entry of the amendment above, claims 14-48 will be pending, claims 14, 15, 29, and 44 being independent.

Summary of the Office Action

As indicated on the cover page, the Examiner has acknowledged the priority claim and receipt of the certified copy of the priority application. In addition, as evidenced by the Examiner-initialled PTO-1449 form, the Examiner has acknowledged his consideration of Applicant's previously filed information disclosure statement.

The Examiner has provided suggested guidelines for the specification, although no objection has been raised with regard to the specification.

Claim 14 is rejected under 35 USC §112, second paragraph, as being indefinite. In particular, claim 14 includes the expression "said device a cover covering" and no antecedent basis is provided for the expression "said sole" in line 5.

Claims 14-22, 25, 26, and 28 are rejected under 35 USC §102(b) as being anticipated by ELLIS et al. (U.S. Patent No. 3,206,874, hereinafter "ELLIS").

Claims 14-22, 25, 26, and 28 are rejected under 35 USC §102(b) as being anticipated by O'DONNELL (U.S. Patent No. 3,068,593).

Claims 14, 15, 19, 26, and 28 are rejected under 35 USC §102(b) as being anticipated by French Patent Publication No. 2 361 837 (hereinafter "LANDRY").

Claim 27 is rejected under 35 USC §103(a) as being unpatentable over ELLIS.

Claims 23 and 24 are identified as containing allowable subject matter, but are objected to for depending from rejected claims.

Response to the Office Action**A. Miscellaneous**

Initially, Applicant expresses his appreciation for the Examiner's consideration of the information disclosure statement and her acknowledgement of Applicant's priority claim and receipt of the certified copy thereof.

B. Withdrawal of the Objection to the Specification

In response to the objection to the declaration, Applicant has attached hereto a substitute specification.

Amendments have been made to the specification of a cosmetic nature, including the addition of section headings suggested by the Examiner.

However, Applicant has chosen not to include section headings which are not applicable to the instant application, with respect to the suggestion in the Office action that, in lieu of text within such sections, the words "Not Applicable" be inserted. Acceptance of the substitute specification with this omission is requested.

If the Examiner were to such sections be included, however, Applicant will submit a further amendment is requested by the Examiner.

The substitute specification includes amendments of a cosmetic nature, including amendments which enable closer correspondence with claim terminology.

Further, in line 9 of paragraph [0030], *i.e.*, the first paragraph following the brief description of the drawings, Applicant has changed "instep 21" to "flexion fold 21" for consistency with line 4 of that paragraph, where reference numeral 21 is used to identify the flexion fold zone of the shoe 10.

Still further, a sentence was added to each of paragraphs [0031] and [0035], based at least upon features of the invention illustrated in the drawings, as will be explained further below in connection with newly added claims. In paragraph [0031], Applicant refers to the contour of the longitudinally extending edge of the cover 1, shown at least in Fig. 3, which is seen to follow (*i.e.*, generally parallels) the contour of the closing zone 12). In paragraph [0035], Applicant refers to the relationship between the contour of the lower edge of the cover 1 (see, *e.g.*, Fig. 5), which is spaced from the sole 9 of the boot progressively along the edge from front to rear.

C. Withdrawal of Rejection Under 35 USC §112, Second Paragraph

Two issues are raised in the rejection of claim 14 for indefiniteness.

Regarding the first issue, in the amendment above, Applicant has amended claim 14 to insert the word "including" in line 5 (of the currently presented claim), which is believed to address and resolve the alleged indefiniteness.

Regarding the second issue, Applicant submits that the expression "said sole" in the last line has antecedent basis, although the expression "said front end of said sole" did not previously have antecedent basis. In the amendment above, therefore, Applicant has amended the latter expression to read "said front end of said shoe", for which antecedent basis can be found in line 3 of the currently presented claim.

In view of the amendments, Applicant requests that the rejection of claim 14 be reconsidered and withdrawn.

D. Withdrawal of Rejections Based Upon ELLIS or O'DONNELL

Applicant requests that the Examiner reconsider and withdraw her rejection based upon ELLIS and her rejection based upon O'DONNELL, at least for the following reasons.

Each of independent claims 14 and 15 includes the limitation of the cover extending from

a flexion fold zone of the shoe to a front end zone of the shoe/sole. The rejections are based upon the assertion that each of ELLIS and O'DONNELL discloses a device covering the upper front surface of the shoe and extending from the flexion fold zone to the front end zone of the shoe.

Applicant respectfully submits that this assertion is wrong.

Neither ELLIS nor O'DONNELL, which are directed to improvements in "safety shoes," includes a description regarding a cover extending to *a flexion fold zone*. First, with regard to ELLIS, his guard flap 36 is described as extending "rearwardly over the toe, metatarsal and instep portions of the shoe" (see column 1, lines 38-43, and similar descriptions in column 3, lines 7-9, and column 4, lines 18-21). Regarding O'DONNELL, see column 2, lines 50-51: "its trailing edge extends upwardly over the instep portion of the upper." The drawings of both of ELLIS and O'DONNELL also show the guard flap extending as described.

The instep and the flexion fold are two different zones. Considering a direction from the toes to the heel, the parts of the foot (i.e., or footwear) are the metatarsals, then the instep, and the flexion fold zone (also known as the flexion crease, where, with regard to the foot, a crease or fold appears where the foot and the lower leg pivot with respect to one another, and, with regard to an article of footwear, the leather or other material from which the upper is made, has a fold or crease).

In fact, both of the ELLIS and O'DONNELL patents provide corroborating evidence that the guard flap 36 (ELLIS) and the protector flap 32 (O'DONNELL) do not extend to a flexion fold. In the two paragraphs appearing in column 1, lines 29-37, and column 3, line 71, to column 4, line 4, ELLIS explains that his "guard flap ... will not interfere with the free flexing of the foot and shoe while walking" Similarly, see column 1, lines 30-31 of O'DONNELL: "... the protector is relatively light and compact and will not interfere with the flexing of the shoe"

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That is, if the guard flap/protector of ELLIS and O'DONNELL do not interfere with the flexion of the foot or shoe, it would not appear possible that the guard flap/protector, which is made of steel or other rigid material (column 3, lines 2-6 of ELLIS and column 2, lines 54-56 of O'DONNELL), could extend to the area of the flexion fold of the shoe.

Further, there would have been no reason to have modified the guard flap/protector of ELLIS or O'DONNELL in a way that would have resulted in Applicant's invention. As explained in *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), a proposed modification is inappropriate as a consideration regarding obviousness under 35 USC §103 when such modification would have rendered the prior art reference inoperable for its intended purpose.

Still further, neither ELLIS nor O'DONNELL teach or suggest a guard flap/protector that extends "from a tibial support zone to a metatarsophalangeal articulation zone and/or the zone of the base of the toes," as Applicant specifies in his claim 19. Further, for the reason given in the immediately preceding paragraph, there would have been no reason to have modified the guard flap/protector of ELLIS or O'DONNELL in a way that would have extended it as far as the tibial support zone.

Finally, Applicant submits that ELLIS fails to teach or suggest the provision of a *plurality* of covers having different rigidities, as specified in Applicant's claim 27. The reference made in the rejection of claim 27 for obviousness to column 3, lines 2-6 of ELLIS relates to the material from which *the* guard flap 36 could possibly be made. No mention is made there that a *plurality* of guard flaps are to be provided, each having a different rigidity. The attributes of strength mentioned at column 3, lines 2-6 of ELLIS are "a strong metal" and "other rigid high impact materials." There is no reason given nor implied within the disclosure of ELLIS that the guard flap should be more or

less rigid than as disclosed.

On the other hand, Applicant's provision of the availability of a *plurality* of covers of varying rigidities permits the wearer to select one from among the plurality of covers which best suits the use to which the article of footwear is to be put, such as the sport in which the wearer is to be engaged, as explained in the final paragraph of the original specification. This feature is nowhere taught or suggested by ELLIS. Further, inasmuch as varying the rigidity of the guard plate 36 of ELLIS would have no affect on the controlling the rigidity of his safety shoe because it does not extend to the flexion fold zone and because the "free flexing" of the foot and the shoe of ELLIS is not to be affected in any event, as explained above, one skilled in the art would not have considered providing a plurality of guards having varying rigidities.

At least for the reasons given above, reconsideration and withdrawal of the rejection of claim 27 is requested.

E. Withdrawal of Rejection Based Upon LANDRY

Applicant requests that the Examiner reconsider and withdraw her rejection based upon LANDRY, at least for the following reasons.

Each of independent claims 14 and 15 includes a limitation regarding a cover extending from a flexion fold zone of the shoe to a front end zone of the shoe/sole. The rejections are based upon the assertion that LANDRY discloses a device "covering said upper front surface of said shoe and extending from said flexion fold zone to said shoe to said front end zone of said shoe."

Applicant respectfully submits that this assertion is wrong. The final sentence on page 2 of the description of LANDRY explains that the removable shell 2 does not cover the front end of the shoe.

At least in view of this difference, reconsideration and withdrawal of the rejection is requested.

F. New Claims

In the amendment above, Applicant has added new claims 29-47, of which claims 29 and 44 are independent.

Independent claim 29 is directed to an assembly of an article of footwear and a device "for increasing flexural rigidity" of the article of footwear. The device includes a cover that covers the flexion fold zone of the article of footwear and extending forwardly at least to the front end zone of the article of footwear.

Neither ELLIS nor O'DONNELL teach or suggest a cover that covers a flexion fold of an article of footwear. Further, for reasons explained above, it would have been contrary to the teachings of both ELLIS and O'DONNELL to have modified their guard/protector to so cover a flexion fold zone, although it is not clear that the boots of either ELLIS or O'DONNELL even include a flexion fold zone.

In addition, like claims 14 and 15, claim 29 calls for the cover to extend at least to the front end zone of the article of footwear, whereas the shell of LANDRY does not extend to the front end zone, as mentioned above.

Of the claims that depend from independent claim 29, Applicant will mention certain ones.

Claim 31 calls for the cover to extend from a tibial support zone to a zone of a metatarsophalangeal joint of the article of footwear and/or a zone of a base of the toes of the article of footwear. Of course, neither ELLIS nor O'DONNELL disclose a cover that extends to a tibial support zone.

Claim 35 calls for the cover to be attached to the front end zone of the sole, which is not taught or suggested by LANDRY.

Likewise, claim 36 calls for the cover to be attached to a forward zone of the sole, which forward zone extends forwardly from the front end of a plantar arch of the sole. By contrast, in LANDRY, the straps 10, 11 are positioned to be secured at the sole near a median part of the shoe beneath the arch.

Claim 37 calls for the cover to contact the sole being connected to the sole "only in said forward zone of said sole."

Claim 40 refers to the spacing of the cover from the sole of the article of footwear. As can be seen, *e.g.*, in Fig. 5, claim 40 calls for the cover to be spaced above the sole at the plantar arch thereof, a distance greater than the distance that the cover is spaced above the sole at the front end zone of the article of footwear.

Claim 41 also refers to such spacing. It calls for the cover to be spaced above a *median part* of the sole a distance greater than the distance that the cover is spaced above the sole at the front end zone of the article of footwear.

Claim 42 also refers to the spacing of the cover from the sole. Such spacing relates, *e.g.*, to the objective of the invention whereby a portion of the upper can be made more rigid, while plantar sensitivity is retained, as mentioned on page 2, line 30, to page 3, line 2 of the original specification. That is, the characteristics of the shoe/boot can be adapted to the conditions of the sport to which a boot might be used. In any event, claim 42 refers to the lower edge of the cover having a longitudinally extending contour that generally follows the longitudinally extending contour of the closing zone. See, *e.g.*, the contour of the closing zone 12 seen in Fig. 3.

Claim 43, like claim 27, specifies a "plurality of covers" having respectively different rigidities.

Independent claim 44 is specifically directed to an assembly that includes a "snowboard boot." None of ELLIS, O'DONNELL, and LANDRY relates to a snowboard boot. Further, the assembly of claim 44 is one that is for increasing flexural rigidity of the snowboard boot. As mentioned above, both ELLIS and O'DONNELL specifically do not affect the flexing of their shoes.

Further, claim 44 calls for the cover of the device to be "attached to a front end zone of said snowboard boot and extending rearwardly to cover said flexion fold zone." Of course, the rigid shell of the device of LANDRY is not connected to a front zone of the shoe.

Dependent claim 47 specifies that the cover is attached *only* to a front end zone of the sole.

Claim 48, like claims 27 and 43, is directed to an assembly that includes a plurality of covers having respectively different rigidities.

G. Amendment of the Title of the Invention

Lastly, Applicant has amended the title of the invention to be more succinct and in closer conformance with the invention, as well as in closer conformance with Applicant's representative's understanding of USPTO guidelines.

SUMMARY AND CONCLUSION

The grounds of objection and rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

Any amendments to the claims presented above, which have not been specifically noted to overcome a rejection based upon prior art, particularly claims which have had cosmetic amendments

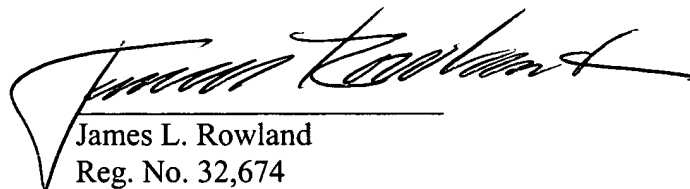
made, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach to such amendments.

A check is enclosed for payment of a claim fee. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicant requests an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
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